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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Toshio Kiriya

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EXAMINER

WILLIAMS, LELA

ART UNIT

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1794

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/585,661	Applicant(s) KIRIYAMA ET AL.	
	Examiner LELA S. WILLIAMS	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/07/2006, 08/20/2008, 07/29/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Saito et al. U.S. Pub. No. 2004/0086624.

Saito et al. discloses a solution and gel which comprises acid- soluble soybean protein in the state of dissolution in a polar solvent ([0012,0021-0023, 0046]), wherein the pH falls within the presently claimed range of 2.5 to 4.8 ([0012,0046,0051]), and the acid-soluble protein content falls within the presently claimed range of 0.5 to 20% by weight ([0021-0023, 0046,0051]). The solution and gel can be utilized in food products ([0012, 0091-0094]), can be dried to form a powder ([0046, 0051]), and can be molded to form a desired shape ([0088, 0093]).

3. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Morehouse et al. U.S. Pat. No. 3,966,971.

Morehouse et al. discloses a solution which comprises acid- soluble soybean protein in the state of dissolution in a polar solvent, wherein the pH falls within the presently claimed range of 2.5 to 4.8, and the acid-soluble protein content falls within the presently claimed range of 0.5 to 20% by weight (col. 1, lines 50-60). The solution is disclosed for use in food products (col. 1,

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lines 25-30) and the liquid can be dried to form solids (col. 2, line 29). Although the reference does not explicitly teach the product as molded, it is inherent that since the product (in liquid or dried form) is to be used in beverages (col. 1, line 28, Ex.2) it will be placed in a container, and it will conform or mold to fit the shape of the container, thus yielding a molded product.

4. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by McCabe U.S. Pat. No. 3,733,207.

McCabe discloses a solution which comprises acid- soluble soybean protein in the state of dissolution in a polar solvent (col. 1, lines 56-57 & col. 2, line 1), wherein the pH falls within the presently claimed range of 2.5 to 4.8 (col. 2, line 5 & lines 52-55), and the acid-soluble protein content falls within the presently claimed range of 0.5 to 20% by weight (col. 1, line 50). The solution is disclosed for use in food products (col. 1, line 35) and the liquid can be dried to form solids (col. 2, line 41). Although the reference does not explicitly teach the product as molded, it is inherent that since the product (in liquid or dried form) is to be used in food and beverages (col. 2, lines 40-43, Ex.2-4) it will be placed in a container, and it will conform or mold to fit the shape of the container, thus yielding a molded product.

5. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Magnino et al. U.S. Pat. No. 3,853,839.

6. Magnino et al. discloses a solution which comprises acid- soluble soybean protein in the state of dissolution in a polar solvent, wherein the pH falls within the presently claimed range of 2.5 to 4.8 (col. 2, lines 25-32), and the acid-soluble protein content falls within the presently

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claimed range of 0.5 to 20% by weight (col. 3, line 44). The solution can be dried to form a powder product (col. 5, line 39) and can be used in food and beverages, such as pudding which is disclosed as frozen or canned, thereby yielding a molded product (col. 8, lines 18-20).

7. Claims 1 and 3-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Chinese Patent 1253173.

CN 1253173 discloses a solution which comprises acid- soluble soybean protein in the state of dissolution in a polar solvent, wherein the acid-soluble protein content falls within the presently claimed range of 0.5 to 20% by weight (page 3). The solution is used to prepare wine and although the wine is liquid, the acid- soluble soybean protein which is added to the liquid is in powder form (page 3). Although the reference does not explicitly teach the product as molded, it is inherent that since the product (in liquid or dried form) is to be used in the production of a wine beverages (page 2, line 1) it will be placed in a container, and it will conform or mold to fit the shape of the container, thus yielding a molded product.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chinese Patent 1253173.

Regarding claim 2, the solution as described in paragraph 7 above does not specifically disclose the pH value of the beverage; however it does disclose the addition of tartaric acid or citric acid into the drink (pg. 3 & claim 3), so the solution is acidic. It would be within the ambit of a person of ordinary skill in the art to obtain the pH by routine test. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” See *In re Aller*, 220 F.2d 454, 456, 105 USPQ

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233, 235 (CCPA 1955). The discovery of an optimum value of a known result effective variable, without producing any new or unexpected results, is within the ambit of a person of ordinary skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980) (see MPEP § 2144.05, II.).

Therefore, it would have been obvious to one of ordinary skill in the art to determine the amount of acid which would produce a suitable pH value, including that presently claimed, for use in an acidic food product or an alcoholic drink.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. JP 2002-262838 and WO 00/62623 are cumulative to the rejections of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LELA S. WILLIAMS whose telephone number is (571)270-1126. The examiner can normally be reached on Monday to Thursday from 7:30am-5pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LELA S. WILLIAMS
Examiner, Art Unit 1794

/L. S. W. /
Examiner, Art Unit 1794

/Callie E. Shosho/
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